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09/863,897	05/23/2001	Anna Karri	944-003.088	9365

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EXAMINER

NGUYEN, JOSEPH D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 05/19/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,897

Applicant(s)

KARRI ET AL.

Examiner

Joseph D Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 11 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim (6,597,918).

Regarding claim 1, Kim discloses a method for use in conveying a plurality of messages from a sending terminal to a receiving terminal over a telecommunications system that is at least in part a wireless telecommunications system (abstract, fig. 1, col. 1 lines 24-31), the method comprising:

a) the sending terminal assembling the plurality of messages in a desired order according to inputs by a user (col. 1 line 49 thru col. 2 line 34),

b) the sending terminal indicating in each message the order of the message in the desired order (fig. 1-3, col. 3 line 7 thru col. 4 line 34);

c) the sending terminal sending (transmitting) all of the messages to the receiving terminal in response to an input by the user (col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34);

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wherein the plurality of messages conveys a plurality of frames so that each frame is conveys one or more of the messages, and wherein each frame is logically related to at least one other of the frames (when there is limited length of message in each frame for the long message, the long message needs more than one frame which means there are a plurality of messages conveys a plurality of frames) (col. 1 lines 32-45, and col. 2 line 61 thru col. 3 line 43).

Regarding claim 11, Kim discloses an apparatus for use by a sending terminal in conveying a plurality of messages to a receiving terminal via a wireless communications network (abstract, fig. 1, col. 1 lines 24-31), the apparatus comprising:

a) means for assembling the plurality of messages in a desired order according to inputs by a user (col. 1 line 49 thru col. 2 line 34),

b) means for indicating in each message the order of the message in the desired order (fig. 1-3, col. 3 line 7 thru col. 4 line 34);

c) means for sending (transmitting) all of the messages to the receiving terminal in response to an input by the user (col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34);

wherein the plurality of messages conveys a plurality of frames so that each frame is conveys one or more of the messages, and wherein each frame is logically related to at least one other of the frames (when there is limited length of message in each frame for the long message, the long message needs more than one frame which means there are a plurality of messages conveys a plurality of frames) (col. 1 lines 32-45, and col. 2 line 61 thru col. 3 line 43).

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Regarding claim 24, Kim disclose a system comprising:

a) a sending terminal, adapted for conveying to a receiving terminal via a wireless communications network a plurality of messages, and including in each message ordering information indicating a position for the message in a desired ordering of the plurality of messages (fig. 1-2, col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34); and

b) the receiving terminal, adapted for receiving the plurality of messages and ordering the message in the desired order as indicated by the ordering information (fig. 1-2, col. 1 line 53 thru col. 2 line 34, and col. 3 line 7 thru col. 4 line 34).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 4-8, 12-18, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (6,597,918) in view of Shiimori (6,567,983).

Regarding claim 2, Kim further discloses the method of claim 1, further comprising the sending terminal associating with a frame of the plurality of frames is displayed (col. 1 line 53 thru col. 2 line 3, and col. 2 line 61 thru col. 3 line 5). However, Kim does not specifically disclose a special effect to be performed when the frame is displayed.

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Shiimori teaches the sending terminal associating with a frame of the plurality of frames a special effect to be performed when the frame is displayed (fig. 4, col. 7 line 38 thru col. 8 line 25). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Kim system with the teaching of Shiimori of a special effect to be performed when the frame is displayed in order to make the message or picture more exciting to see.

Regarding claim 4, Kim does not specifically disclose the method of claim 2, wherein the special effect is selected from the group comprising vibrating the frame, providing a sound when the frame is first displayed, providing a sound when the frame is closed, opening the frame in stages, and closing the frame in stages.

Shiimori teaches the special effect is selected from the group consisting of vibrating the frame, providing a sound when the frame is first displayed, providing a sound when the frame is closed, opening the frame in stages, and closing the frame in stages (fig. 10, col. 10 line 45 thru col. 12 line 28). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of Shiimori of special effect in order to make the message more special to the recipient.

Regarding claim 5, Kim further disclose the method of claim 1, further comprising the sending terminal preparing a frame of the plurality of frames by indicating messages to be displayed in the frame (fig. 1, col. 2 line 64 thru col. 3 line 43). However, Kim does not specifically disclose a picture and text to be displayed in the frame.

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Shiimori teaches a picture to be displayed in the frame and/or by providing text to be displayed in the frame (col. 1 line 53 thru col. 3 line 53). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of Shiimori of picture and message to be displayed in the frame in order to make the message more special to the recipient.

Regarding claim 6, Kim further discloses the method of claim 1, further comprising the sending terminal. However, Kim does not specifically disclose the sending terminal downloading from a service an already-created message and editing the text of a frame of the plurality of frames to personalize the plurality of frames for an assumed operator of the receiving terminal.

Shiimori teaches the method of claim 1, further comprising the sending terminal downloading from a service an already-created message and editing the text of a frame of the plurality of frames to personalize the plurality of frames for an assumed operator of the receiving terminal (fig. 4-8, 12-14, col. 7 lines 11-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of Shiimori of picture and message to be displayed in the frame in order to make the message more special to the recipient.

Regarding claim 7, Kim further discloses the method of claim 1, further comprising the sending terminal. However, Kim does not specifically disclose the sending terminal downloading from a service or retrieving from stored memory an already-created picture for use as the picture of a frame of the plurality of frames and optionally providing text to be associated with the picture.

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Shiimori further discloses the method of claim 1, further comprising the sending terminal downloading from a service or retrieving from stored memory an already-created picture for use as the picture of a frame of the plurality of frames and optionally providing text to be associated with the picture (fig. 4-8, 12-14, col. 7 lines 11-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of Shiimori of picture and message to be displayed in the frame in order to make the message more special to the recipient.

Regarding claim 8, Kim further discloses the method of claim 1, wherein the plurality of frames is provided using a pre-existing message service selected from the group comprising short message service (SMS), extended message service (EMS), and multimedia messaging service (MMS) (abstract, col. 1 line 49 thru col. 2 line 28).

Regarding claim 12, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 13, Shiimori further discloses the method of claim 12, further comprising means for reviewing properties of a frame of the plurality of frames, including whether or not a special effect has been associated with the frame (col. 16 lines 7-14).

Regarding claim 14, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 15, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 16, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 17, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 18, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 21, Kim further discloses a system according to claim 24, further comprising: a server wirelessly coupled to the sending terminal and to the receiving terminal (#140 fig. 1, col. 1 lines 24-46, and col. 3 lines 11-43). However, Kim does not specifically disclose, a server providing a picture to either the sending terminal or the receiving terminal in response to a request for the picture from either the sending terminal or the receiving terminal.

Shiimori teaches a server providing a picture to either the sending terminal or the receiving terminal in response to a request for the picture from either the sending terminal or the receiving terminal (abstract, #30 fig. 1, col. 6 lines 29-51). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Kim system with the teaching of Shiimori of a server providing a picture to sending or receiving terminal in order to allow the user to receiving the picture to edit it with personal message.

Regarding claim 22, Shiimori further discloses the system of claim 21, wherein the server for providing a picture in response to a request for the picture does so in

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response to a bookmark (image) communicated by the receiving terminal according to the a wireless application protocol abstract, #30 fig. 1, col. 6 lines 29-51).

Regarding claim 23, Shiimori further discloses the system of claim 21, wherein the server for providing a picture in response to a request for the picture does so in response to request communicated by the sending terminal, thereby making available the picture for use by the sending terminal in composing (editing) one or more of the plurality of messages (fig. 3-4, 9-10, 12-14, col. 6 line 29 thru col. 10 line 39).

5. Claims 9, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (6,597,918) in view of Lundstrom et al. (6,665,522).

Regarding claim 9, Kim further discloses the method of claim 1, wherein the plurality of frames. However, Kim does not specifically disclose the plurality of frames consists of three ordered frames, each frame comprising a picture and associated text personalized for an intended recipient.

Lundstrom et al. teaches the plurality of frames consists of three ordered frames, each frame comprising a picture and associated text personalized for an intended recipient (col. 5 lines 1-48). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify Kim system with the teaching of Lundstrom et al. of three ordered frame in order to provide the receiver device to determine the number of frames it must receive in order to receive the complete message.

Regarding claim 19, this claim is rejected for the same reason as set forth in claim 9.

6. Claims 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (6,597,918) in view of Schreiber et al. (6,353,892).

Regarding claim 10, Kim further discloses the method of claim 1. However, Kim does not specifically disclose, wherein the plurality of frames is protected from being copied using a form of protection selected from the group comprising: copy protection, digital rights management, and encryption.

Schreiber et al. teaches the frame is protected from being copied using a form of protection selected from the group comprising: copy protection, digital rights management, and encryption (title, col. 18 lines 22-50). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify Kim system with the teaching of Schreiber et al. of copy protection in order to protect personal information from unauthorized recipient.

Regarding claim 20, this claim is rejected for the same reason as set forth in claim 10.

Response to Arguments

7. Applicant's arguments with respect to claims 1-2, 4-24 have been considered but are moot in view of the new ground(s) of rejection.

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Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

a. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

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(703) 305-9509 (for informal or draft communications, please label

"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA. Sixth floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D Nguyen whose telephone number is (703) 605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Joseph Nguyen



May 14, 2004



WILLIAM TROST
SUPERVISORY PATENT EXAMINER
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